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MAILED
OCT 25 1993
GROUP 2300

This is in response to the communication re the Power of Attorney filed October 21, 1993.

assignee.

1. ☒ The power of attorney to you in this application has been revoked by the applicant.

2. ☐ In view of the notice in this application of the death of _____ his power of attorney is terminated.

3. ☒ The power of attorney to you in this application has been accepted by the Commissioner of Patents, & Trademarks.

4. ☐ The assignee in this application has intervened and appointed an attorney of his own selection. Further correspondence will be held with said attorney. (Rule 36, Rules of Practice.)

5. ☐ The revocation of the power of attorney to _____ has been entered and said attorney has been notified. Further correspondence will be addressed to you.

assignee

6. ☐ On _____, the applicant appointed _____ as additional attorney in this application. Further corresponce will continue to be addressed to you as specified in the new power of attorney.

assignee

7. ☐ On _____, the applicant appointed _____ as additional attorney in this application. Further correspondence will be addressed to said attorney. MPEP 403.02

8. ☐ The associate power of attorney to you in this application has been revoked by the attorney of record.

Michael E. Gergosits
Dergosits & Noah
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San Francisco, CA 94111

For Director, Operation

RETAIN THIS COPY IN THE APPLICATION FILE

FORM PTOL-305 (REV. 2/92)

Copy A

1. The terminal disclaimer filed 1/3/94 has been entered and thus overcomes the obvious-type double patenting rejection set forth in the previous Office action.

2. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification as originally filed does not provide support for the invention as is now claimed.

As mentioned in the previous action, the specification does not provide specific support for the variety of storage media used in the information storage means. Note claim 67 which recites such media as the "video CD" and the "magnetic storage medium". Further note that similar recitations were stricken from corresponding claim 15 in the amendment filed 12/7/93. While applicant has provided arguments concerning the inclusion of "video" information products, these arguments do not extend to the content of the information storage means in the kiosk.

Furthermore, the recitation of "maintaining control" of playback "throughout the duration of the selection playback" inserted into the remaining independent claims is not clearly supported by the specification as originally filed. The original specification

discusses the playback of a "30 second clip" of the selected song but is silent with regard to what kind of control is established or maintained for the user during this playback. While the operation of the device kindly demonstrated by applicant included the capability to stop selection playback or skip to the playback of other selections, no hint of this capability is specifically or explicitly provided in the specification. Moreover, while matter may be added to the specification that simply renders explicit that which was implicitly disclosed, it is not seen where the specification even implies that the user maintains control for the specific interval of the duration of the selection playback. Even though it is possible that such control *could be* provided considering the equipment used, such control is not implicit, required or inherent in the specified system or method of use.

3. Claims 14-24, 26-29, 33-34, 38-39, 66-76, 78-81, 85-86, 90-91 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

4. Claim 67 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 67, it is not clear what a "video CD" is.

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6. Claims 14-17, 22-23, 26, 33, 38, 66-69, 74-75, 78, 85 and 90-91 are rejected under 35 U.S.C. § 103 as being unpatentable over Stern et al.

Stern et al. teaches a method and apparatus for previewing recorded information from audio and video information products available for sale wherein the user identifies to the apparatus the selection to be previewed using a keyboard, and an excerpt therefrom is reproduced without opening the product's packaging. The apparatus includes an optical disk storage means for storing the excerpts and optical disk playback means to reproduce the disks.

With respect to the recitation of maintaining control throughout playback, assuming for the sake of argument that this is somehow implied by the player in the specification, this limitation is then seen to be met by Stern as implied by the

existence of the optical disk players in Stern since such players are well known to be provided with controls for pausing, stopping or skipping the playback of selections. Further, Stern provides no indication that these controls are locked out during this playback. Note the return of the playback loop in the flow chart of fig. 11.

While Stern does not specifically teach both a means for enabling the user to identify the product to be previewed and means for enabling the user to choose among selections from the product, the album cover buttons of Stern do simultaneously identify the product and the selection to be previewed from the display of a plurality of product selections. Furthermore, considering that artists, recording labels etc. are well known to release a plurality of "singles" from one album or product and considering the desire of a user to associate "particular music or video selections with a particular tape album or disc" when attempting to purchase the product as recognized in the background of Stern, it would have been obvious to those of ordinary skill in the art to modify the teachings of Stern to include the means allowing the user to choose among selections on the product to increase the ability of the user to associate particular selections with a particular product.

In addition, while Stern does not teach the use of a touch screen, such a touch screen is recognized in the background art of Stern. Thus, it would have been obvious to those of ordinary skill in the art to modify the teachings of Stern to include a touch screen so as to make use of off-the-shelf components.

Finally, concerning the recitation of using a "product code" to identify the product to the system, note that this is not necessarily associated with the product's packaging or any bar code and thus is broad enough to read on the codes generated by the keyboard and decoder of Stern in response to the pushing of one of the buttons.

See the abstract, figs. 1, 8 and 11, col. 1 lines 15-44, col. 2 lines 3-22, col. 3 lines 3-61 and col. 4 lines 8-48 of Stern.

7. Claims 18-21, 27-29, 70-73 and 79-81 are rejected under 35 U.S.C. § 103 as being unpatentable over Stern et al. as applied to claims 14-17, 22-23, 26, 33, 38, 66-69, 74-75, 78, 85 and 90-91 above, and further in view of Hughes.

Stern fails to specifically teach the gathering of frequency data concerning the selections. Hughes, however, teaches the collection of frequency information, which in addition to providing royalty information also obviously informs the business employing the system of the popular selections. See the abstract of Hughes. Thus, it would have been obvious to those of ordinary skill in the art to modify the teachings of Stern to include the collection of frequency information as taught by Hughes so as to identify popularity trends in selections.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Riddell et al. (GB 2218081) teach a dispensing machine that provides previews of audio or video products.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Weinhardt whose telephone number is (703) 305-9780.

Facsimile transmissions may be directed to (703) 305-9564 or 9565.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

February 10, 1994

ROBERT A. WEINHARDT
PRIMARY EXAMINER
GROUP 2300